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July 20, 2007

BY CM/ECF

The Honorable Sue L. Robinson
United States District Court for the District of Delaware
J. Caleb Boggs Federal Building
844 N. King Street
Wilmington, Delaware 19801

Re: *Cordis Corp. v. Boston Scientific Corp.*, C.A. No. 98-197-SLR

Dear Judge Robinson:

I write on behalf of Boston Scientific in response to Cordis's July 11, 2007 letter submitting the new case of *Young v. Lumenis*, ___ F.3d ____, 2007 WL 1827845 (Fed. Cir. June 27, 2007) as supplemental authority. D.I. 332.

Cordis argues that *Young* now enables it to distinguish the "cure" standard of *Rohm & Haas Co. v. Crystal Chemical Co.*, 722 F.2d 1556 (Fed. Cir. 1983), because *Young* distinguished *Rohm & Haas* on the grounds that *Rohm & Haas* "involved a false affidavit, rather than a non-disclosure, and [*Young*] further held that the cure for a prior omission is a timely submission. *Young* at *10-11." D.I. 332 at 1.

Cordis's reliance on *Young* is misplaced. Unlike *Young*, this is not a case that involved only non-disclosure of material information which could be cured by later disclosing the information in time for the examiner to consider it. *Young*, 2007 WL 1827845 at *10-*11. Dr. Fischell did not merely intentionally withhold the Hillstead reference during the parent '312 prosecution. He also repeatedly and falsely told the examiner that the prior art did not disclose the undulating longitudinal feature that was critical to patentability, when, in fact, that feature

was admittedly disclosed by Hillstead. After the examiner relied on those false arguments to allow the '312 claims, Dr. Fischell and Cordis did nothing during the continuation '370 prosecution to correct the impact of those false arguments on the examiner. They did not tell the examiner that Hillstead disclosed undulating longitudinals or that Dr. Fischell's previous arguments were false. Instead, they buried Hillstead among some sixty references, remained silent, and let the examiner continue to believe that undulating longitudinals were not disclosed in the prior art. In view of the examiner's prior reliance on the earlier false arguments, this cryptic disclosure of Hillstead could not and did not cure the prior inequitable conduct. *See* D.I. 324 at 22-25; D.I. 328 at 10-14.

Thus, the facts of this case are not like those of *Young*. Rather, they are much closer to those of *Rohm & Haas*, which involved an earlier misrepresentation on which the examiner had previously relied to allow claims. 722 F.2d at 1572. As the Federal Circuit explained in *Rohm & Haas*, the impact of such a misrepresentation cannot be cured by "merely suppl[ying] the examiner with accurate facts without calling his attention to the untrue or misleading assertions sought to be overcome, leaving him to formulate his own conclusions." *Id.*

Indeed, the Federal Circuit recognized the applicability of *Rohm & Haas* and the fact that this case did not involve only non-disclosure when it cited *Rohm & Haas* and specifically instructed this Court on remand to address "whether, in light of the context in which the Hillstead patent was disclosed and the applicant's characterization of the prior art, that disclosure failed to cure the taint." *Cordis Corp. v. Boston Scientific Corp.*, 2006 U.S. App. LEXIS 16621, *14-*15 (Fed. Cir. June 29, 2006) (citing 722 F.2d at 1572-73).

Respectfully submitted,

/s/ Karen E. Keller

Karen E. Keller (#4489)

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